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35844 7590 12/05/2008 PAULEY PETERSEN & ERICKSON 2800 WEST HIGGINS ROAD HOFFMAN ESTATES, IL 60169			EXAMINER CHRISS, JENNIFER A	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RAYMOND JEFFREY MAY,
JAMES MARCUS CARR,
MICHAEL SCOTT BRUNNER,
LAVADA CAMPBELL BOGGS,
HANNONG RHIM, JAMES RUSSELL FITTS, JR.,
KENNETH MICHAEL SALTER,
VICTOR CHARLES LANG,
ADRIAN ROY EGGEN, and
OOMMAN PAINUMOOTTIL THOMAS

Appeal 2006-1394
Application 09/855,188
Technology Center 1700

Decided: November 28, 2007

Before CHARLES F. WARREN, THOMAS A. WALTZ, and
JEFFREY T. SMITH, *Administrative Patent Judges*.

WALTZ, *Administrative Patent Judge*.

REQUEST FOR REHEARING

This is a decision on a Request for Rehearing (hereafter “Request”) dated Sep. 6, 2006, filed pursuant to 37 C.F.R. § 41.52(a)(1) (2006),

requesting rehearing of the Decision dated June 30, 2006 (hereafter “Decision”), where this merits panel affirmed both grounds of rejection based on 35 U.S.C. § 103(a) (Decision 3).

Appellants submit that the Decision is contrary to prevailing legal principles (Request 1) in that the “Board applied an overly broad interpretation to the terms ‘first elastomeric polymer’ and ‘second elastomeric polymer’” (Request 2). Appellants cite *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005), for the holding that the claims must be read in view of the specification (Request 2). Appellants argue that their Specification expressly discloses that the first and second elastomeric polymers are not identical, thus disclaiming the broader definition that the two polymers are identical (*id.*). Appellants cite portions of their Specification to support this argument (Request 2-3). The remainder of the Request (4-7) is directed to a reiteration of Appellants’ arguments from the Appeal Brief and Reply Brief.

We do not find Appellants’ arguments convincing of error in our Decision for the following reasons. As cited by Appellants (Request 3), *Phillips* is concerned with the claim language in a *patent*. In this appeal, we are concerned with the claim language during *ex parte* prosecution of a patent application. During *ex parte* prosecution, the Patent & Trademark Office (PTO) determines the scope of the claims by giving the language “the broadest reasonable construction ‘in light of the specification as it would be interpreted by one of ordinary skill in the art.’” *Phillips*, 415 F.3d at 1316, quoting *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004); see also *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997) (Decision 5). As held by the court in *In re Am. Acad. of Sci. Tech. Ctr.*,

367 F.3d at 1364:

Giving claims their broadest reasonable construction ‘serves the public interest by reducing the possibility that claims, finally allowed, will be given broader scope than is justified.’
[Citation omitted].

....

Construing claims broadly during prosecution is not unfair to the applicant (or, in this case, the patentee), because the applicant has the opportunity to amend the claims to obtain more precise claim coverage. ... ‘When an application is pending in the PTO, the applicant has the ability to correct errors in claim language and adjust the scope of claim protection as needed.’ [*quoting In re Yamamoto*, 740 F.2d 1569, 1571-72 (Fed. Cir. 1984)].

As stated in our Decision, we find no express disclaimer of this broad definition in Appellants’ Specification, but merely a preference for differences in composition of the first and second elastomeric polymers (Decision 5-6). The PTO should not import limitations from the specification into the claims, but should only limit the claim based on an express disclaimer of a broader definition. *See In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004) (Decision 5).¹ We further note that Appellants present an extensive “**DEFINITIONS**” section in their Specification where they had the opportunity but failed to define that the first and second elastomeric polymers must be different (Specification 6-12). We also note that Appellants have the ability to correct any errors in the claim language by amending the claim scope to the preferred embodiment where the first

¹ *See also Phillips*, 415 F.3d at 1323 (“In particular, we have expressly rejected the contention that if a patent describes only a single embodiment, the claims of the patent must be construed as being limited to that embodiment. [Citation omitted].”).

and second elastomeric polymers must be different, but have failed to do so.² As held by the court in *In re Morris*, 127 F.3d at 1056:

We decline to attempt to harmonize the applicants' interpretation with the application and prior art. Such an approach puts the burden in the wrong place. It is the applicants' burden to precisely define the invention, not the PTO's.

....

The problem in this case is that the appellants failed to make their intended meaning explicitly clear. Even though the appellants implore us to interpret the claims in light of the specification, the specification fails to set forth the definition sought by the appellants.

As noted in our Decision (5-6), Appellants' Specification merely sets forth "preferred" or "desired" embodiments but nowhere expressly *limits* the first and second elastomeric polymers to be different materials (e.g., Specification 12:9-10; 20:2-4; and 36:9-11). The burden is on Appellants to precisely define the invention and make their intended meaning explicitly clear. We determine that Appellants have not met their burden in this appeal. Accordingly, we determine that the claim construction presented in our Decision has not been shown to be in error.

² We note that dependent claims 3 and 4 recite that the first and second polymers must be different, but Appellants have not presented any arguments regarding these claims (Decision 6). Since we are not concerned with a patent, the doctrine of claim differentiation does not apply here. However, these dependent claims emphasize that claim 1 on appeal requires a broad construction and that Appellants have had the opportunity to amend claim 1 to clarify the scope but have failed to do so.

With regard to the reiteration of Appellants' arguments presented in the Appeal Brief and Reply Brief (Request 4-7), we adopt our previous comments that adequately responded to these arguments (Decision 6-7).

For the foregoing reasons and those presented in the Decision, we have considered Appellants' Request for Rehearing but find no argument convincing of error in our original Decision. Therefore, the Request for Rehearing is DENIED.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

DENIED

tf/ljs

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